

REMARKS

Claims 77-86 and 109-148 are pending in the current application. Applicants have amended claims 77, 109, 119, 128, and 137. Reexamination and reconsideration of all claims, as amended, is respectfully requested.

§ 102

The Office Action rejected claims 77 and 109 under 35 U.S.C. § 102(b) based on Dotson, Jr., U.S. patent 4,274,411 (“Dotson”).

Dotson discloses a fluid operated irrigation and aspiration device including two valves 91 and 95. The two valves operate to favorably position passageways 92 and 98 therein, where in the configuration shown in FIG. 2, passageway 92 being positioned as shown between lines 90 and 94 enables fluid to flow between the lines, and passageway 98 being positioned away from lines 99 and 100 inhibits fluid flow through passageway 98 and keeps fluid from flowing between line 99 and line 100. A footpedal implementation (footpedal 12, using valves 14 and 15) is also shown.

Applicants have amended all independent claims, including claims 77 and 109, to recite that a series of modulated differential pressure pulses is applied to the ocular region via a fluid control device “configured to deform aspiration tubing providing aspirating fluid from the ocular region...” (Claim 77, with similar limitations in claim 109 and the other independent claims). Dotson does not show deformation of aspiration tubing as claimed, but instead keeps all illustrated tubing intact and undeformed, and thus claims 77 and 109 are not anticipated by Dotson.

Accordingly, it is respectfully submitted that all pending claims fully comply with 35 U.S.C. § 102.

§ 103

The Office Action rejected claims 77, 80-86, 109, 112-116, 119, 122-125, 128, 130-134, 137-139, and 141-146, including independent claims 77, 109, 119, 128, and 137

under 35 U.S.C. § 103 based on Dotson in view of Bylsma, U.S. Patent No. 6,319,220 (“Bylsma”). The Office Action rejected all other pending dependent claims based on Dotson in view of Bylsma and further in view of Gonan, U.S. Patent 6,423,028, and certain arguments regarding claiming ranges/values.

Dotson is discussed in detail above. Bylsma discloses a general phacoemulsification apparatus “configured for random pulse mode operation.” (Abstract) While not abundantly explained or differentiated in much detail within Bylsma, the Bylsma “random pulse mode operation” relates to the application of ultrasonic energy during the phacoemulsification procedure. Conventional fluid application is disclosed in Bylsma, and the Office Action relies on Bylsma for the ultrasonic aspects of the reference, not the pulsed fluid aspects, presumably because Bylsma does not exhibit pulsed fluid aspects. As each independent claim includes a limitation such as “applying modulated differential fluid pressure pulses to the ocular region by deforming aspiration tubing providing aspirating fluid from the ocular region...,” and deforming aspiration tubing in this manner is neither suggested nor disclosed by Dotson alone, or Bylsma alone, or Dotson in combination with Bylsma, Applicants submit that all independent claims, as amended, are allowable over the cited references.

Combination of References

Dotson is solely relied on as purportedly showing the fluid aspects of the claims. Bylsma is solely relied on for showing the ultrasonic limitations of the claims. Applicants disagree that one of ordinary skill in the art would have a reason to combine the features disclosed in the Bylsma and Dotson references in the manner suggested in the Office Action. Applicants submit that a combination of Bylsma and Dotson is unreasonable, and such a combination is using hindsight to reconstruct the claimed invention. As noted, neither Dotson nor Bylsma apply modulated differential fluid pressure pulses to the ocular region by deforming aspiration tubing providing aspiration tubing from the ocular region. Bylsma does not discuss modulated differential fluid

application, or pulsed fluid application, and thus would not be relied on to solve the problem currently solved by the present design.

The PTO has the burden of establishing a *prima facie* case of obviousness under 35 USC §103. The Patent Office must show that some reason to combine the elements with some rational underpinning that would lead an individual of ordinary skill in the art to combine the relevant teachings of the references. *KSR International Co. v. Teleflex Inc.*, No. 04-1350, 550 U.S. ____ (2007); *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). Therefore, a combination of relevant teachings alone is insufficient grounds to establish obviousness, absent some reason for one of ordinary skill in the art to do so. *Fine* at 1075. In this case, the Examiner has not pointed to any cogent, supportable reason that would lead an artisan of ordinary skill in the art to come up with the claimed invention.

None of the references, alone or in combination, teaches the unique features called for in the claims. It is impermissible hindsight reasoning to pick a feature here and there from among the references to construct a hypothetical combination which obviates the claims.

It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. [*citation omitted*]

In re Gordon, 18 USPQ.2d 1885, 1888 (Fed. Cir. 1991).

A large number of devices may exist in the prior art where, if the prior art be disregarded as to its content, purpose, mode of operation and general context, the several elements claimed by the Applicant, if taken individually, may be disclosed. However, the important thing to recognize is that the reason for combining these elements in any way to meet Applicant's claims only becomes obvious, if at all, when considered from hindsight in the light of the application disclosure. The Federal Circuit has stressed that

the “decisionmaker must step backward in time and into the shoes worn by a person having ordinary skill in the art when the invention was unknown and just before it was made.” *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1566 (Fed. Cir. 1987). To do otherwise would be to apply hindsight reconstruction, which has been strongly discouraged by the Federal Circuit. *Id.* at 1568.

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553 (Fed. Cir. 1983). Therefore, without some reason in the references to combine the cited prior art teachings, with some rational underpinnings for such a reason, the Examiner’s conclusory statements in support of the alleged combination fail to establish a *prima facie* case for obviousness.

See, KSR International Co. v. Teleflex Inc., No. 04-1350, 550 U.S. ____ (2007) (obviousness determination requires looking at “whether there was an apparent reason to combine the known elements in the fashion claimed...,” *citing In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness,” KSR at 14)).

The reasoning supporting the combination is “to provide a system that aids in the aspiration of hard to remove pieces of material...” Office Action, p. 4. This is merely a conclusion used to justify choosing references based on aspects presented in the claims. It is always beneficial to improve operation, cost, efficiency, and so forth, but the question is what reasoning would have been used by one to take the ultrasonic teachings of Bylsma and modify them in a manner consistent with the Dotson fluid design. Here, no such reason has been articulated. Conclusory reasoning such as that presented is improper hindsight reconstruction of the invention, and for this further reason, claims 77,

109, 119, 128, and 137, as amended, and claims depending therefrom are allowable over the cited references.

Based upon the totality of the foregoing, Applicants respectfully submit that claims 77, 109, 119, 128, and 137, as amended, are allowable over the references of record, and all claims dependent therefrom are also allowable as they include limitations not present in the cited references .

Accordingly, it is respectfully submitted that all pending claims fully comply with 35 U.S.C. § 103.

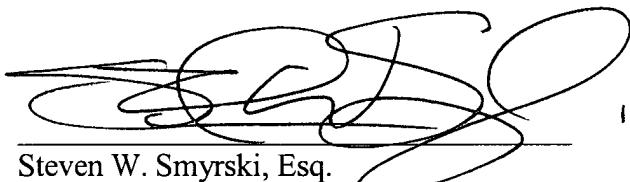
CONCLUSION

In view of the foregoing, it is respectfully submitted that all claims of the present application are in condition for allowance. Reexamination and reconsideration of all of the claims, as amended, are respectfully requested and allowance of all the claims at an early date is solicited.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Applicants believe that no fees are due in accordance with this Response. Should any fees be due, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment to Deposit Account 502026.

Respectfully submitted,



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